

## REMARKS

In response to the Office Action mailed April 28, 2009, Applicants respectfully request reconsideration of the Application in view of the foregoing Amendments and the following Remarks. The claims as now presented are believed to be in allowable condition.

Claims 4, 6, 10-11, 15, 17, and 21-22 have been canceled. Claims 1-3, 5, 7-9, 12-14, 16, and 18-20 remain in this application, of which claims 1 and 12 are independent claims.

### Rejection of Claims 1, 3, 5, 8-9, 12, 14, 16, and 19-20 under 35 U.S.C. §103(a)

Claims 1, 3, 5, 8-9, 12, 14, 16, and 19-20 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Publication No. US 2001/0038704 to Ito et al. (hereafter referred to as “Ito”) in view of U.S. Patent No. 6,625,755 to Hirata et al. (hereafter referred to as “Hirata”). Applicants respectfully traverse this rejection.

In giving an obviousness rejection, the Examiner bears the initial burden of factually supporting a prima facie conclusion of obviousness. (See, MPEP, §2142). To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be *some suggestion or motivation*, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, *the prior art references* must teach or suggest *all the claim limitations*. (See, MPEP, §2142.) (Emphasis added.)

The rejection of claims 1 and 12 under 35 U.S.C. §103(a) as being unpatentable over Ito in view of Hirata is not appropriate because these prior art references fail to teach or suggest all the limitations of claims 1 and 12 and because there is no motivation or suggestion in these references to combine or modify these references to the present invention.

In particular, claims 1 and 12 recite that a retry of reading or writing of the data with one of the required time period (in step A) or the predetermined maximum number of retries (in step D) is performed after the step of determining the type of data and in both cases of the data being and not being of the predetermined type of data.

On page 3 of the Office Action dated April 28, 2009, the Examiner combines Hirata and Ito by stating:

Specifically, the process proceeds as follows: at step B15 of Ito, the data can be detected as either D-data, whose reliability is more important (see [0067]), or AV data, whose continuity is more important (see [0069]). If it is of D-data, the retrying process with predetermined maximum number of retries is performed as shown in the control flow following the “NO” branch of step B15 in Fig. 3 of Ito. Otherwise, it is determined as AV data, and the retrying process with required time period as disclosed and suggested by Hirata would follow the “YES” branch of step B15 of Ito.

The Examiner states that one of ordinary skill in the art would be motivated to incorporate the retrying process of Hirata into the YES branch of step B15 of Ito.

However, Ito repeatedly teaches away from performing any retry process in the “YES” branch of step B15 of Ito which touts just omitting any retrying process in such a “YES” branch, many times through-out the disclosure of Ito.

**The Examiner is respectfully reminded of the MPEP, §2141.03(VI) which states  
“PRIOR ART MUST BE CONSIDERED IN ITS ENTIRETY, INCLUDING  
DISCLOSURES THAT TEACH AWAY FROM THE CLAIMS”:**

**A prior art reference must be considered in its entirety, i.e., as a whole,  
including portions that would lead away from the claimed invention.**

For example, the Abstract of Ito states:

....Therefore, in the case of data whose reading-out continuity is more important than reliability, the retry process is omitted, so that time required for reading-out processing can be shortened. In the case of data whose recording continuity is more important than reliability, the verifying processing is omitted so that time required for writing processing can be shortened.  
(Emphasis Added.)

Repeatedly again, paragraph [0015] of Ito states:

[0015]....Therefore, in the case of data whose reading-out continuity is more important than reliability, the retry processing is omitted, and the reading-out processing time can be shortened. (Emphasis Added.)

Repeatedly again, paragraph [0017] of Ito states:

[0017]....Therefore, in the case of data whose recording continuity is more important than reliability, the verifying process is omitted, and the writing processing time can be shortened. (Emphasis Added.)

Repeatedly again, paragraph [0023] of Ito states:

[0023] According to the data reading-out method, it is determined whether the retry processing for the defect should be executed depending upon the determined kind of data, and when it is determined that the retry processing should not be executed, the reading-out of data next to the series of data is continued, and when it is determined that the retry processing should be executed, the retry processing for the detected defective sector is executed.  
(Emphasis Added.)

Repeatedly again, paragraph [0057] of Ito states:

[0057] On the other hand, when the digital watermark is embedded in the data, it is determined Yes in step A14, and it is determined that the data is the AV data. In this case, the CPU 12 completes the processing without carrying out the verifying processing for the AV data.  
(Emphasis Added.)

Repeatedly again, paragraph [0058] of Ito states:

[0058] ....With this feature, the verifying processing is omitted when the data is the AV data which regards continuity as more important than the reliability, so that time required for writing processing can be shortened.  
(Emphasis Added.)

Repeatedly again, paragraph [0069] of Ito states:

[0069] ....In this case, the CPU 12 completes the processing, without carrying out the retry processing for the AV data irrespective whether or not there is a defect.  
(Emphasis Added.)

Repeatedly again, paragraph [0070] of Ito states:

[0070] ....In this manner, the data judging section 16 determines whether the data is the D data or the AV data depending upon whether the digital watermark exists, and only when the data is D data, the retry processing for the defect position is carried out. With this feature, the retry processing is omitted when the data is AV data whose continuity is more important than reliability, so that time required reading-out processing can be shortened.  
(Emphasis Added.)

Repeatedly again, paragraph [0074] of Ito states:

[0074] ....Further, in case of the AV data, the retry processing itself is not carried out. Therefore, although the reproduced pictures may become messy a little, there is no inconvenience such as stopping reproducing many times as in the conventional method.  
(Emphasis Added.)

Thus, Ito repeatedly touts omitting any retry process for processing AV data for enhancing continuity of AV data.

Accordingly, Ito repeatedly teaches away from the limitation of performing a retry of reading or writing of the data in both cases of the data being and not being of the predetermined type of data.

Thus, one of ordinary skill in the art upon reading the disclosure of Ito would not be motivated to incorporate the retrying process of Hirata into the YES branch of step B15 of Ito since Ito repeatedly touts omitting any retry process in the YES branch of step B15 of Ito.

**The Examiner is again respectfully reminded of the MPEP, §2141.03(VI) which states “PRIOR ART MUST BE CONSIDERED IN ITS ENTIRETY, INCLUDING DISCLOSURES THAT TEACH AWAY FROM THE CLAIMS”:**

**A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.**

On page 2 of the Office Action dated April 28, 2009, the Examiner states:

...But nowhere in Ito reference is found to state that for that type of data or AV data, retrying processing cannot be performed.

However, the standard of MPEP, §2141.03(VI) is not whether the prior art reference states that the retrying process cannot be performed.

Rather, the standard of MPEP, §2141.03(VI) is whether the prior art reference includes disclosure that would teach away from the limitations of the claims. Ito repeatedly touts the advantage of enhanced continuity of AV data processing by completely omitting any retry process in the YES branch of step B15 of Ito.

Accordingly, a prima facie conclusion of obviousness of claims 1 and 12 cannot be established because Hirata and/or Ito fail to teach or suggest all the limitations of claims 1 and 12, and the rejection of claims 1 and 12 under 35 U.S.C. §103(a) should be withdrawn.

Claims 3, 5, and 8-9, which depend from and further limit claim 1, are allowable for at least the same reasons that claim 1 is allowable as stated above.

Claims 14, 16, and 19-20, which depend from and further limit claim 12, are allowable for at least the same reasons that claim 12 is allowable as stated above.

**Rejection of Claims 2, 7, 13, and 18 under 35 U.S.C. §103(a)**

Claims 2 and 7, which depend from and further limit claim 1, are allowable for at least the same reasons that claim 1 is allowable as stated above.

Claims 13 and 18, which depend from and further limit claim 12, are allowable for at least the same reasons that claim 12 is allowable as stated above.

### Conclusions

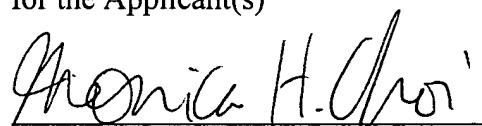
In view of the foregoing amendments and remarks, this application should now be in condition for allowance. A notice to this effect is respectfully requested. Please feel free to contact the undersigned should any questions arise with respect to this case that may be addressed by telephone.

***If the Examiner disagrees, an Advisory Action is requested to be mailed ASAP such that the Appeal may be reopened within the 3-Month of the Mailing Date of the Office Action made Final.***

Respectfully submitted,  
for the Applicant(s)

Dated: June 26, 2009

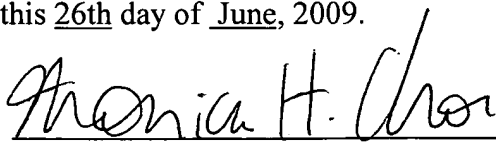
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### CERTIFICATE OF MAILING

The undersigned hereby certifies that the foregoing AMENDMENT AND RESPONSE AFTER FINAL UNDER 37 C.F.R. §1.116 is being deposited in the United States Postal Service, as first class mail, postage prepaid, in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 26th day of June, 2009.



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